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§ 8.06 Selected Problems in Claim Drafting

A complete discussion of techniques of drafting appropriate and effective claims is beyond the scope of the present work.¹ The following sections consider selected common problems that arise with claim drafting and Patent and Trademark Office policy toward particular kinds of claim language.

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[4]--Multiplicity and Duplication--Separate Claims as ``Separate Patents''

An applicant may present more than one claim¹ and is afforded reasonable latitude in varying the scope and terminology with which he defines his invention.

Courts iterate that ``each claim of a patent is treated as if it was a separate patent."² This is true in the sense that each patent claim must be separately assessed in determining infringement and validity.³ However, patent law does not treat separate claims as separate patents for all purposes,⁴ and certain defenses, such as inequitable conduct, impact the entire patent.⁵ Also, in *Pope Mfg. Co. v. Gormully & Jeffery Mfg. Co.* (1892),⁶ the Supreme Court held that an attempted assignment of a separate claim gave the assignee no standing to sue for infringement: ``While it is sometimes said that each claim of a patent is a separate patent, it is true only to a limited extent. Doubtless separate defenses may be interposed to different claims, and some may be held to be good and others bad, but it might lead to very great confusion to permit a patentee to split up his title within the same territory into as many different parts as there are claims."⁷

Rule 75(b) of the Patent and Trademark Office provides (and for many years has provided): ``More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied."⁸

In *Carlton v. Bokee* (1873),⁹ the Supreme Court commented briefly on the duplication and needless multiplication of claims.

``The single claim of the original patent is expanded [in the reissued patent] into seven distinct claims. The first three of these claims, taken with the qualifications which they contain, and limited as they must be by the state of the art at the time when the original patent was applied for, amount to precisely the same thing and to no more than the one claim of the original patent. ... If they mean anything more than the claim in the original patent they are void. Being identical with that they are needlessly multiplied, and by exhibiting a seeming of claims to which Reichmann was not entitled they are calculated to confuse and mislead. We think it proper to reiterate our disapprobation of these ingenious attempts to expand a simple invention of a distinct device into an all-embracing claim, calculated by its wide generalizations and ambiguous language to discourage further invention in the same department of industry and to cover antecedent inventions. Without deciding that a repetition of substantially the same claim in different words will vitiate a patent, we hold that where a specification by ambiguity and a needless multiplication of nebulous claims is calculated to deceive and mislead the public, the patent is void."¹⁰

Early decisions in the Patent Office sought to discourage the common practice of presenting a large number of claims for examination. In *Ex parte Whitelaw* (1914),¹¹ Commissioner Ewing apparently required separate claims to be patentably distinct from each other: ``The claims held patentable are considered as fully covering applicant's invention, and applicant cannot be permitted to multiply his claims by presenting alleged combinations which distinguish from the real invention only by including elements which are old in the art and perform no new function." In *Ex parte Duncan* (1919),¹² Assistant Commissioner Clay saw the evil of multiplicity in claiming as the creation of confusion and indefiniteness.

``When a simple invention is claimed over and over in mere variations of language, the necessary result is to confuse and to fail to point out the invention as the statute requires. ... If one points out the same thing twice, he does not point out that thing distinctly. The very fact that the same structure is claimed twice renders the set of claims indistinct, because there is no justification in a patent for two claims to the same thing, and when the reader finds two claims he necessarily looks for them to be drawn to different things. ...

``Undoubtedly a patentee may claim his invention in several scopes--that is, in its broad aspect and also in its narrow aspect--and he may also separately claim several related inventions; but there is no authority for the Commissioner to issue a patent with several claims to the same thing."¹³

In *Ex parte McCullough* (1926),¹⁴ Commissioner Robertson stressed the burden of undue multiplicity on the Office. The application in question contained 27 pages of specification and 325 claims covering 70 pages. While recognizing that an applicant is to be granted ``all reasonable latitude" in claiming and may ``restate his invention in different phraseology a reasonable number of times," the Commissioner found a ``flagrant abuse of that privilege."

``The presentation of an application in the form in which this one was originally filed merely clogs the work in the Office. It is unfair, not only to inventors generally, but it is unfair to the particular applicant, if he has other applications pending, and to other clients of the present attorneys. Obviously the mere reading of this mass of claims, to say nothing of the time it would take if they are to be compared with the prior art and with each other, would take time which should properly be devoted to the determination of the question whether the applicant had really made an invention over the prior art and, if so, what that invention is.

“There is at the present time no greater abuse than the filing of applications with a mass of undigested claims. Patents which have issued from this Office with a very large number of claims have been repeatedly criticized by the courts, and the filing of such applications has been repeatedly and bitterly criticized by committees in Congress. ...”¹⁵.

In 1927, Congress revised the Patent Office fee structure to provide for filing and issue fees of “\$1 for each claim in excess of twenty.”¹⁶ In *Ex parte Jenkins* (1930),¹⁷ Commissioner Robertson rejected the argument that the statute changed prior practice on multiplicity and required “examination of each claim no matter how many there were and regardless of the differences between them.”

Beginning in the 1930s, decisions by the Court of Customs and Patent Appeals and the Board of Appeals softened Office practice on multiplicity and duplication. The *Whitelaw* rule that claims must be patentably distinct from each other was abandoned.¹⁸ In *In re Savage* (1940),¹⁹ the court stressed that “to warrant a rejection ... claims must be not only of greater number than necessary to protect an invention, but they must be of a character ‘the net result of which is to confuse, rather than to clarify, the issues.’”

In 1949, the Patent Office adopted Rule 75(b), expressly prohibiting undue multiplicity and requiring that claims “differ substantially from each other.”²⁰

In the two *Chandler* cases, the Court of Customs and Patent Appeals affirmed rejections for undue multiplicity and formulated a “rule of reason.” In *Chandler I* (1958),²¹ the applicant presented 50 claims. The Office found that number excessive and suggested that 20 claims would be adequate. The invention was “not of an exceptionally complex nature” and there were instances of substantial duplication. The Court agreed.

“[I]t is proper to allow applicants a reasonable latitude in setting forth their inventive concepts in different phraseology, but it is the purpose of claims to point out and define what an applicant regards as his invention, and that purpose is not served if, as the result of frequent repetitions, they present to the mind a blur rather than a definition.

“... No two claims are identical and therefore it is possible to argue, in each instance, that the difference might become important under some hypothetical future circumstances. The extent to which virtual duplication of claims may be justified by possible remote contingencies is a matter of opinion which must be determined on the basis of the circumstances of each individual case. It is necessary to balance the possible damage to an applicant which might result from an insufficient number of claims against the burden imposed upon the Patent Office and the courts by the presentation of an unreasonably large number.”²²

In *Chandler II* (1963),²³ the court again affirmed a multiplicity rejection, despite the applicant's arguments that only 38 claims were presented and that the invention was more complex. The Office cited examples of claims that did not “materially differ from each other.” The latitude allowed applicants “in stating their claims in regard to number and phraseology employed” “should not be extended to sanction that degree of repetition and multiplicity which beclouds definition in a maze of confusion.”

In more recent decisions, the court has become more critical of multiplicity rejections.²⁴ In *In re Flint* (1969),²⁵ the court affirmed the principles stated in *Chandler II* but reversed a rejection of an application presenting 42 claims. Four were independent claims. To each independent claim, a set of dependent claims was attached, containing corresponding limitations. The examiner noted that the six reference patents cited contained an average of 7.5 claims. The Board of Appeals reasoned that “even if the features added by the dependent claims were to be found novel over the prior art, their repetition with more than one base claim differing only in scope is not justifiable.” The court disagreed.

“We are not prepared to judicially notice ... that the dependent claims add only conventional elements commonly known. Moreover, the board's statement acknowledges a difference in scope between the base claims. ...

“... The claims differ from one another and we have had no difficulty in understanding the scope of protection. Nor is it clear ... that the examiner or board was confused by the presentation of the claims in the case or that the public will be.”²⁶

In *In re Wakefield* (1970),²⁷ the court stressed that claims could not be rejected as being “unnecessary” unless the large number of claims is such as to obscure the invention. It seemingly eliminated the factor of burden on the Office. The applicant claimed a certain synthetic homopolymer and inserted 31 claims. The Board of Appeals found that many of the claims merely added inherent properties, and obvious variations, such as somewhat more restricted ranges of components. The court ruled that “there is no statutory authority for rejecting claims as being ‘unnecessary’”: “an applicant should be allowed to determine the necessary number and scope of his claims, provided he pays the required fees and otherwise complies with the statute.” It found no such multiplicity that would obscure the invention.

"Each appealed claim is relatively brief and clear in its meaning. Examination of forty claims in a single application may be tedious work, but this is not reason for saying that the invention is obscured by the large number of claims. We note that the claims were clear enough for the examiner to apply references against all of them in his first action."
28.

Patent and Trademark Office practice with multiplicity rejections resembles that for restriction and election.29.

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